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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/608,819 | 06/30/2000 | Russell M. Krapf | K35A0627 | 2409 |
| 26332 | 7590 | 10/20/2005 | EXAMINER | |
| WESTERN DIGITAL CORP. 20511 LAKE FOREST DRIVE C205 - INTELLECTUAL PROPERTY DEPARTMENT LAKE FOREST, CA 92630 | | | VU, NGOC K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2611 | |

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,819

Applicant(s)

KRAPF, RUSSELL M.

Examiner

Ngoc K. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-18 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/18/2005 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-4, 6-18 and 20-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 12-15, 16-18 and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (US 20020056099 A1).

Regarding claim 12, Takahashi discloses a method of operating a video system that receives video data that includes a plurality of premium contents (promotion program and ordinary programs - see 0038, 0053, 0057, 0058), the method comprising:

creating a viewer profile representing viewing preferences of a viewer (see 0089);
identifying premium content (ordinary program) from the plurality of premium contents consistent with the viewer profile (see 0088, 0089);
locally storing the identified premium content from the plurality of premium contents (memory 34 and memory 36 locally store video signal and audio signal of ordinary program – see 0062, 0065);
selecting a promotion content (motion images as promotion program) associated with the identified, locally stored premium content (ordinary program) (see 0083, 0084, 0090);
storing the selected promotion content on a local storage device (70); and
retrieving the selected promotion content from the local storage device (see 0094, 0095) and displaying the selected promotion content to entice the viewer to watch the identified, locally stored premium content (ordinary program) (for instance, a detailed screen as the motion image-annexed EPG in which the motion images produced as the promotion program are disposed beside the guide text as shown in figure 7. That is, the promotion program information included motion image is displayed to entice the viewer to watch ordinary program “ROUND MIDNIGHT” - see 0095, 0098 and figure 7).

Regarding claim 13, Takahashi teaches that the selected promotion content occurs upon determined that the viewer is watching video data displayed on a video display (viewing history or viewing habit) (see figure 7 and 0089).

Regarding claim 14, Takahashi teaches displaying the identified, locally stored premium content (ordinary program) corresponding to the displayed selected promotion content (promotion program) upon the viewer selecting the displayed selected promotion content (for instance, the user selects a program on the program selecting screen displaying a promotion program information - see figure 7; 0062, 0065 and 0098).

Regarding claim **15**, Takahashi teaches creating a plurality of viewer profiles, each viewer profile representing viewing preferences of a viewer and including at least one preferred promotion content selected in accordance with the viewing preferences of the viewer (see 0088-0089).

Regarding claim **16**, Takahashi teaches selecting a viewer profile from the plurality of viewer profiles upon which viewer is likely to watch at a given day and time using the viewing preferences (for instance, based on viewing history from a viewer profile to select a promotion program to be watched at a given day and time, e.g., October 24 and 21:00-23:00 – see figure 7; 0088-0089).

Regarding claims **17 and 18**, Takahashi teaches that the plurality of premium contents received from the headend includes a plurality of conditional access video contents provided through a pay-per-view service (PPV program) (see 0041).

Regarding claim **20**, Takahashi teaches scrambling the at least one conditional access video content (scrambling a program) prior to locally storing it (see 0054, 0059).

Regarding claims **21 and 22**, Takahashi teaches descrambling the scrambled program upon fulfillment of a condition for access or payment of a fee (see 0059 and 0041).

Regarding claim **23**, Takahashi teaches that the promotion module causes display of the selected at least one preferred promotion content as a video clip (see figure 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-4, 6, 10, 11 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (US 20020056099 A1) in view of Corvin et al. (US 20010029610 A1).

Regarding claim 1, Takahashi discloses a video system, comprising:

an input port (4 – see figures 1 & 4) configured to receive video data from a headend (1 – see figure 1), the video data including a plurality of premium contents (promotion program and ordinary programs) (see 0038, 0053, 0057, 0058);

an output port (37- see figure 4) configured to couple to a video display (7 – see figure 1) for displaying video data selected by a viewer (see 0039, 0063);

a preference engine (68 – see figure 5) configured to track viewer selections of the video data and to create a viewer profile representing viewing preferences of a viewer (see 0089);

a storage device (34 and 36) configured to locally store premium content from the plurality of premium contents (memory 34 and memory 36 locally store video signal and audio signal of ordinary program – see 0062, 0065);

a local storage device (68, 70 – see figure 5); and

a promotion module (69 – see figure 5) coupled to the preference engine and the output port, the promotion module (69) responsive to the viewer profile to select one of the promotion content (motion images as promotion program) from the plurality of premium contents, to cause the selected at least one preferred promotion content to be stored on the local storage device (i.e., 70) (see 0083, 0084, 0090), and to cause the selected at least one preferred promotion content to be retrieved from the local storage device (see 0094, 0095) and displayed to entice the viewer to watch the locally stored premium content (ordinary program) associated with the selected at least one preferred promotion content (motion images as promotion program) (for instance, a detailed screen as the motion image-annexed EPG in which the motion images

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produced as the promotion program are disposed beside the guide text as shown in figure 7. That is, the promotion program information included motion image is displayed to entice the viewer to watch ordinary program "ROUND MIDNIGHT" - see 0095, 0098 and figure 7).

Takahashi does not teach storing the premium content (ordinary program) in a personal video recorder. However, Corvin teaches recording a program in a storage unit such as a VCR located locally at or near a user's television viewing equipment (see 0038-0039). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Takahashi by storing a program in a VCR located locally at or near a user's television viewing equipment as taught by Corvin in order to allow the user to control playback of the stored program locally.

Regarding claim 2, the combined system of Takahashi and Corvin comprises a set-top box configured to receive video data (Takahashi: within receiver 5 – see figures 1 & 4; Corvin: see 0035).

Regarding claims 3 and 4, Takahashi teaches that the plurality of premium contents received from the headend includes a plurality of conditional access video contents provided through a pay-per-view service (PPV program) (see 0041).

Regarding claim 6, Takahashi teaches that the promotion module causes display of the selected at least one preferred promotion content as a video clip (see figure 7).

Regarding claim 10, Takahashi teaches that the promotion module is configured to cause a plurality of sets of data to be stored on the on the local storage device (68 & 70), each set of data including a viewer profile and at least one preferred promotion content associated with the viewer profile (see 0088-0089).

Regarding claim 11, Takahashi teaches that the promotion module uses the viewer profiles to select a set of sets of data from the plurality of sets of data upon determining which

viewer is likely to watch at a given day and time (for instance, based on viewing history from the viewer profile to select a promotion program to be watched at a given day and time, e.g., October 24 and 21:00-23:00 – see figure 7; 0088-0089).

Regarding claim **24**, Takahashi as modified by Corvin teaches that the VCR comprises the local storage device (see Corvin: 0038).

Regarding claims **25 and 27**, Takahashi does not teach that the local storage device comprises a hard disk drive. However Corvin further teaches storing the selected promotion data in a local storage such as a disk drive (see 0039). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Takahashi by storing the selected promotion data in a local storage such as a disk drive as taught by Corvin to provide a removable medium for using somewhere else.

Regarding claim **26**, Takahashi does not teach storing the promotion content (promotion program) in a personal video recorder. However, Corvin teaches recording a promotion data in a storage unit such as a VCR located locally at or near a user's television viewing equipment (see 0038-0039). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Takahashi by storing a promotion data in a VCR located locally at or near a user's television viewing equipment as taught by Corvin in order to allow the user to control playback of the stored data locally.

7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (US 20020056099 A1) in view of Corvin et al. (US 20010029610 A1) and further in view of Ryan (US 6,590,979 B1).

Regarding claim **7**, Takahashi teaches that a first module (at headend 1) configured to scramble at least one of the conditional access video contents received from the headend (see 0041 and 0054). Takahashi and Corvin fail to teach that the personal video recorder locally

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stores the at least scrambled conditional access video content. However, Ryan discloses that it is possible to record a scrambled video signal on a VCR and replay it later for descrambling without incurring significant extra signal degradation (see col. 3, lines 10-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Takahashi and Corvin by recording a scrambled video signal on a VCR and replay it later for descrambling without incurring significant extra signal degradation as disclosed by Ryan for security purpose.

Regarding claims **8 and 9**, Takahashi teaches a second module (i.e., demux 32) configured to de-scramble at least one locally stored scrambled conditional access video content upon fulfillment of a condition for access or payment of a fee (see 0041, 0059, 0060).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ngoc K. Vu', with a long horizontal flourish extending to the right.

Ngoc K. Vu
Primary Examiner
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October 11, 2005